REMARKS

Claims 1-12 and 36-40 are pending.

The invention relates to video sharing, and more particularly to techniques for advertisement-supported video sharing using an automated, network-accessible server. The pending claims are readily distinguishable from the prior art of record, and reconsideration of the previous rejections is respectfully requested. More particularly, the cited art does not teach any system that sends a video segment, or a link thereto, in response to a sender's request to a video server as presently claimed.

Claim Rejections – 35 U.S.C. § 102

Independent Claim 1

The examiner has rejected independent claim 1 as anticipated by U.S. Pat. No. 6,546,555 to Hjelsvold ("Hjeslvold").

As previously noted, Hjelsvold is fundamentally different from the presently claimed invention. Hjelsvold discloses a system for *selling* video content. "The present invention relates to . . . providing customers access through a communications network to digital video information stored on a merchant's server." Col. 1, l. 9-12. As summarized in the first sentence of the Abstract, Hjelsvold discloses a "system for *selling digital video information* over a communications network" Abstract (emphasis added). The primary purchasing model set out in Hjelsvold "allows the customer to select and purchase" information on demand, Col. 12, l. 48-59, *after* the merchant has used various administrative tools to store and parameterize video content. Broadly stated, Hjelsvold teaches a pull-oriented system in which videos are transmitted in response to specific client requests for those videos.

By contrast, the claimed invention teaches a push-oriented system in which videos (or links thereto) are transmitted in response to information provided by a video sender. In operation, the claimed method includes receiving a selection of an advertisement from a sender, and *in response to this selection* (or, in the rubric of the claim, "in response to the indication accepted in step (d)"), *automatically* associating the video segment and the advertisement, and *sending the video segment* and the associated advertisement to a receiving computer system. Stated differently, in the claimed invention a sender uploads

a video *and* specifies at least one recipient so that the system may, in response to the sender input, send the video to the receiving computer system. While Hjelsvold discloses various components of a video distribution system (e.g., a web server, a streaming server, a client), there is no suggestion that these components cooperate in the manner presently claimed. Hjelsvold cannot anticipate the claimed invention.

Nowhere does Hjelsvold teach or suggest a merchant specifying an intended recipient, and nowhere does Hjelsvold teach or suggest responsively and automatically sending a video to the intended recipient. In the language of the claims, Hjelsvold does not teach associating a video segment and an advertisement, and sending the video segment and advertisement to a receiving computer system in response to a sender's selection of an advertisement. Instead, Hjelsvold teaches a system that explicitly sends media ***in response to a purchase request by a customer***. See, e.g., Col. 8, l. 10-24 ("In the next step, step 3, the customer makes a selection and the SET payment transaction is launched. The calculated prices are presented to the customer along with information describing the alternative versions of the selected video"). At best, Hjelsvold teaches that a video is uploaded to a repository where it may be managed by a merchant, and where it may be browsed and purchased by a client. Again stating the difference, the claimed invention includes a system that sends a video in response to the sender's selection of an associated advertisement.

Hjelsvold does not teach or suggest a system that responds to a sender's selection of an advertisement by sending the advertisement and an associated streaming video as claimed in claim 1. Hjelsvold cannot anticipate claim 1, or render claim 1 obvious.

Because claim 1 is patentable over the art of record, claims 2-6 depending therefrom are also patentable. The applicant asks that the examiner reconsider the rejection of these claims.

Claim Rejections – 35 USC § 103

Independent Claim 7

The examiner has rejected independent claim 7 as obvious over Hjelsvold in view of U.S. Pat. No. 6,774,926 to Ellis et al. ("Ellis") and U.S. Pub. No. 2001/0047294 to Rothschild ("Rothschild").

However, Ellis does not bridge the gap left by Hjelsvold. In fact, Ellis provides no teaching of advertisements whatsoever, except for a solitary reference to interactive advertisements that may be included in a program guide. Col. 10, l. 45-49. More specifically, Ellis does not teach sending a video segment in response to a sender's selection of an advertisement for association with the video segment as presently claimed. Ellis and Hjelsvold cannot anticipate claim 7, or render claim 7 obvious, either alone or in combination.

Further, the applicant submits that Ellis is not an analogous art, contrary to the examiner's assertion. Ellis is directed to broadcast media. The structure and function of a broadcast media system is different from the data network used to share videos as presently claimed. This distinction is readily evidenced by the use in Ellis of a television program guide (see e.g. Fig. 10) to support the function of selecting video, and the explicit depiction of a structure that provides a connection between a communications network and the cable system headend from which broadcast media is distributed (see, e.g., Fig. 7). Broadcast media networks are both structurally and functionally different from data networks. A system for adding home videos to a broadcast network system is not reasonably pertinent to a system for advertisement-supported video sharing in a data network, and a person of ordinary skill would not have been motivated to consider broadcast media systems to solve problems associated with advertisement-supported video sharing over data networks.

The applicant also notes that Rothschild was filed on Jan. 5, 2001, more than four months *after* the present application (Aug. 3, 2000), and claims priority to a provisional application filed on January 6, 2000, more than four months *after* the earliest priority claim (Aug. 3, 1999 – U.S. App. No. 60/147,029) for the present application. The applicant requests that the examiner withdraw any objection based upon this reference, or in the alternative that the examiner identify the subject matter in the present claims that the examiner believes is disclosed in the Rothschild priority document but not in the applicant's priority document.

Because independent claim 7 is patentable over the art of record, claims 8-12 depending therefrom are likewise patentable.

Independent Claim 36

The examiner has rejected independent claim 36 over a combination of Rothschild in view of XP-002150023, "Streaming Email" ("Streaming Email").

Claim 36 is directed to a method of operating a video-sharing server that includes:

storing a plurality of advertisements;

receiving from a client a video, an electronic mail address, and a selection of one of the plurality of advertisements;

confirming that the video is in a streaming video format;

storing the video at a network-accessible location;

generating an identification tag including a link to the network-accessible location;

generating an electronic communication containing the link and the selected one of the plurality of advertisements, the electronic communication addressed to the electronic mail address; and

transmitting the electronic communication.

As noted above, Rothschild does not qualify as prior art. Also, after careful examination of the Streaming Email reference, the applicant has been unable to identify a single reference to "advertisement". Additionally, the Streaming Email reference appears to teach against a server-based video sharing system where, for example, the introduction states:

> Both programs [described in this document] are targeted mostly to the consumer market. Consumers can make better use of them because they usually don't have access to web server space to dump their streaming files.

Streaming media, page 303, lines 8-10.

More generally, the present obviousness rejection appears to select various features of prior art disclosures, and then apply hindsight reconstruction to arrange these features in the manner claimed. While the applicant acknowledges that certain teachings of the prior art may usefully serve as elements in the claimed invention, the examiner has yet to identify any motivation *in the prior art* to combine features of the prior art to achieve the claimed invention. The claimed invention provides a server-based system

that users may employ to share videos by simply uploading video, providing an address, and selecting an advertisement. This combination usefully provides an advertisement-supported platform for general video sharing in a networked environment, a result that is not taught or suggested by the prior art of record. The applicant is not simply claiming an aggregation of elements. The applicant is claiming the arrangement and cooperation of these elements to operate a video-sharing server to support advertisement-supported video sharing. It is the elements, in addition to their cooperation, that the applicant claims in claim 36, and it is the absence of these elements and their cooperation in the prior art that renders this claim patentable.

The prior art does not teach the claimed invention. Because independent claim 36 is patentable, claims 37-40 depending therefrom are likewise in condition for allowance, and reconsideration of this rejection is respectfully requested.

Conclusion

The claims currently pending in this case, as amended above, are believed to be in condition for allowance. The applicant therefore requests that the examiner withdraw any outstanding objections and rejections and issue a notice of allowability for pending claims 1-12 and 36-40.

Respectfully submitted
STRATEGIC PATENTS, P.C.

/Robert Mazzarese/

Robert A. Mazzarese
Reg. No. 42,852
Tel.: (781) 453-9993

January 10, 2007